

### **REMARKS**

In the Office Action,<sup>1</sup> the Examiner restricted the claims to group I, claims 1-18, and group II, claims 19-25; elected group I for prosecution; withdrew claims 19-25 from consideration; and rejected claims 1-18 under 35 U.S.C. § 103 as unpatentable over U.S. Patent Application Publication No. 2005/0086204 to *Coiera* in view of U.S. Patent No. 6,167,654 to *Fontana*.

By this response, Applicants have amended claims 1, 10, and 21. Claims 1-25 remain pending.

### **Interview Summary**

Applicants thank the Examiner, Andrea Long, and her Primary Examiner, William Bayshore for their time in conducting a telephonic interview on November 7, 2007. During the interview, the parties discussed possible amendments to claims 1 and 10 to more accurately reflect the disclosed invention. Applicants proposed adding language similar to that shown above in claims 1 and 10, and the Examiners requested Applicants' assurance that the subject matter had adequate support in the specification. Applicants' representatives pointed to the Specification, paragraph 1 of the Background and paragraphs 6, 15-20, and 31 of the Detailed Description as examples of support for the proposed amendments. The Examiners also requested an example of how the proposed claim language would relate to the disclosure on Pages 8 and 9 of the Specification, and an explanation of how the claim amendment distinguished over the

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

art of record, which Applicants' representatives provided. No agreement was reached as to whether the newly proposed claim limitation was allowable.

The parties also discussed the restriction requirement made in the last Office Action. Mr. Bayshore explained that this type of restriction is rare, and if traversed, will be reviewed with the next response. Applicants' representatives noted that while the scope of claims 1, 10, and 19 differ as to the language used to describe a workflow, a process modeling tool and a process, portions of the disclosure inter-relate the claim language. Applicants' representatives noted their traversal and requested that the restriction requirement be withdrawn.

#### **Restriction Requirement**

In order to preserve their Right of Petition, Applicants are traversing this Restriction Requirement, and, as set forth in M.P.E.P. § 818.03, point out the errors in the Requirement. Namely, the Examiner erroneously separated the present invention into two Groups. Group I varies in scope from Group II, but both Groups are disclosed as related subject matter, and accordingly do not warrant any additional search of the art.

In particular, Applicant respectfully notes that under MPEP § 803, in order for a restriction to be proper, the Examiner must establish that (1) the inventions are independent or distinct as claimed and (2) there would be a serious burden on the Examiner if restriction is not required. See MPEP § 803. Furthermore, if the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to

independent or distinct inventions. See id. In this application, the Examiner has not demonstrated that the claims meet both requirements.

The Examiner noted that “[i]nventions are unrelated if it can be shown that they are not disclosed as capable of use together.” Office Action, Page 2. The Examiner then characterized the claims as drawn to un-related subject matter. Office Action, Page 3.

Applicants note that two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect. See MPEP § 802.01. Furthermore, for related inventions to be deemed distinct, the inventions as *claimed* must not be connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is patentable over the other. See id. The Examiner has not met this criteria because the methods and article of the independent claims share similar operations and effects.

Although both Groups are of different scope, both Groups include resource templates, and both groups include constraints, attributes, and contexts. Additionally, Group 1 includes a “process modeling tool” and “workflow,” and Group II includes a “process for completion” and a “process flow.” In describing exemplary embodiments, the Specification discloses that resources must be found in order to perform a task. Page 1, lines 16-18, Page 3, lines 4-10. The resources correspond to “objects,” which are linked to “workflow.” Page 14, paragraphs 0031 and 0032. The “workflow” (Page 8, paragraph 0020) is related to inter-dependent process steps of a “process flow” (Page

7, paragraph 0018-Page 8, paragraph 0020). Accordingly, the claims of each Group are related and should be rejoined. The restriction is improper and should be withdrawn.

Applicants note that the second of two criteria for a proper Restriction Requirement requires that there “must be a serious burden on the examiner if restriction is required.” See M.P.E.P. § 803. By examining the process-related aspects of Group I, the Examiner has already searched subject matter related to Group II. Therefore, no serious burden on the Examiner is present. Therefore, the examination of both Groups would not pose a serious burden on the Examiner, and Applicants traverse the Examiner’s restriction requirement.

Therefore, this Election and traversal serve as a “writing which distinctly and specifically points out” the errors in the Examiner’s Restriction Requirement. See M.P.E.P. § 818.03(a). Furthermore, nothing herein shall be construed as an admission that the claims are not patentably distinct.

**35 U.S.C. § 103**

Applicants respectfully traverse the rejection of claims 1-18 under 35 U.S.C. § 103. No *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, the Examiner must make findings with respect to all of the claim limitations and must make “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See M.P.E.P. §§ 2143.03 and 2141(III), 8th Ed., Rev. 6 (September 2007).

A *prima facie* case of obviousness has not been established with respect to claims 1-18 because, among other things, the Examiner has not made findings with respect to each and every element of Applicants' claims.

Amended claim 1 recites, *inter alia*, "completing workflow of a process modeling tool by using the matching resource."

The Examiner alleges that *Coiera* teaches various claimed features of a "resource template." Office Action, Pages 4-5. Even assuming this allegation is true, which Applicants do not concede, the Examiner admits that "Coiera does not teach wherein the determining is performed in a enterprise management system." Office Action, Page 5. Therefore, *Coiera* cannot teach "completing workflow of a process modeling tool by using the matching resource," as claimed, since the "process modeling tool" is part of an "enterprise management system," as claimed.

The Examiner alleges that "Fontana teaches a system that build[s] maintains[,] and deploys business process applications" and that "Fontana teaches linking domains, business models[,] and components as part of the application's development." Office Action, Page 5. The Examiner also alleges that "[i]t would have been obvious to one skilled in the art at the time the invention was made to have combined the resource template of Coiera with the enterprise management system of Fontana to provide a defined business process, which can be implemented within multiple applications." *Id.* However, these allegations do not constitute "findings with respect to all of the claim limitations." For example, neither the references themselves nor the allegations of the Examiner discuss "completing workflow of a process modeling tool by using the

matching resource," as claimed. Moreover, the references do not support this combination.

*Fontana* "links" objects so that they have a relationship. Column 3, lines 18-31 and Column 4, lines 35-51. The "linking" disclosed by *Fontana* enables development of modules, such as Component Model of Figure 6. Column 9, lines 43-67. While *Fontana's* system can discover applications or locate artifacts (Column 7, line 66-Column 8, line 6), *Fontana* does not disclose the completion of "workflow" using the discovered applications or located artifacts. Therefore, neither this portion, nor any other portion of *Fontana* constitutes or suggests "completing workflow of a process modeling tool by using the matching resource," as claimed. As a result of the missing claim element, the Examiner cannot show what "workflow" of *Fontana* could be completed by an alleged "resource" of *Coiera*. Therefore, the Examiner has not made "findings with respect to all of the claim limitations," and cannot support a conclusion of obviousness.

For at least the above reasons, the Examiner has not established a *prima facie* case of obviousness with respect to the rejection of claim 1. Independent claim 10, though of different scope from claim 1, recites elements similar to those set forth above for claim 1. Claim 10 is therefore allowable for at least the reasons presented above. Claims 2-9 and 11-18 are also allowable at least due to their respective dependence from claims 1 and 10. The rejection of claims 1-18 under 35 U.S.C. § 103 should be withdrawn.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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*for*